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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

60892.000016

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/694,348

Filed

October 28, 2003

First Named Inventor

Othman HAMED, et al.

Art Unit

1731

Examiner

Marc S. Alvo

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

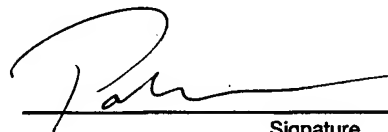
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 35,022

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

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Telephone number

7/29/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 07 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Application of :

Othman HAMED, *et al.*

Serial No.: 10/694,348

Filed: October 28, 2003

For: CHEMICALLY CROSS-LINKED CELLULOSIC FIBER  
AND METHOD OF MAKING SAME

Examiner: Marc S. Alvo

Group Art Unit: 1731

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
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Alexandria, VA 22313-1450

The final Office Action ("the Office Action") dated April 29, 2005, rejects pending claims 37-51 of application No. 10/694,348 ("the present application"). Applicants respectfully request that an appeal conference be held to review the following matters in regards to the present application.

The present application is a continuation of application No. 10/166,254 ("the '254 application"), which is presently being examined by Examiner Alvo. The '254 application also is under final rejection by virtue of an Office Action dated May 17, 2005. The rejections and issues presented by the present application and the '254 application are similar, and consequently, the panel of Examiners may wish to consider both requests at the same time. Applicants will file a separate Pre-Appeal Brief Request for Review in the '254 application on or about August 17, 2005.

Claim 37 of the present application, as amended by applicant's previous responses, from which claims 38-51 depend, is reproduced below:

37. An absorbent article comprising a crosslinked cellulosic fiber having a centrifuge retention capacity of less than about 0.48 grams of a 0.9% by weight saline solution per gram of fiber and a third insult acquisition rate of less than 10 seconds.

Three rejections of claims 37-51 under 35 U.S.C. §§ 102(b) and 103(a) are based in part on alleged admitted prior art (Office Action, page 3, ¶ 1; page 5, ¶ 1; and page 5, ¶ 3). The Office Action alleges that the “[s]pecification’s “Description of Related Art” and pages 15, 16 and 24” are “ADMITTED PRIOR ART” (Office Action, page 3, ¶ 1). Applicants’ previous Request for Reconsideration Pursuant to 37 C.F.R. § 1.111 (“Request for Reconsideration”) dated January 27, 2005, addresses what applicants perceive as an error in these rejections. The Panel is respectfully referred to page 4, ¶ 3 - 4, of the Request for Reconsideration. Applicants submit that the Examiner’s reliance upon the alleged “ADMITTED PRIOR ART” is factually and legally insufficient to support prior art rejections under 35 U.S.C. §§ 102(b) and 103(a).

To reiterate very briefly, applicants do not know what specific art the Examiner considers “ADMITTED PRIOR ART.” While the Examiner has referred in general to certain pages of present specification, these general references lack the requisite specificity to support a rejection. Applicants are at a serious disadvantage in formulating a response to a rejection that does not adequately inform the applicants what specifically is relied upon to reject the claims. The general reference to certain pages in applicants’ specification also falls far short of the legal requirements to support a rejection under either 35 U.S.C. §§ 102(b) or 103(a). Finally, to the extent the Examiner alleges that known cross-linked fibers inherently possess the claimed characteristics, applicants have submitted ample data showing that even applicants’ most preferred fibers cross-linked with applicants’ most preferred cross-linking agents do not necessarily possess the characteristics recited in the present claims. Accordingly, applicants respectfully request that the Panel reconsider and withdraw the rejections based on ADMITTED PRIOR ART.

The rejection of claims 37-51 as inherently anticipated has been maintained (Office Action, page 3, ¶ 1-2; page 4, ¶ 1-2; and page 5, ¶ 4 - page 6, ¶ 1). These rejections rely upon references that do not expressly disclose an absorbent article having “a centrifuge retention capacity of less than about 0.48 grams of a 0.9% by weight saline solution per gram of fiber,” as recited in claim 37. The rejections maintain that, because the alleged prior art describes cellulosic fibers crosslinked with a cross-linking agent, (e.g., glyoxylic acid,) the alleged prior

art-fibers must inherently possess the required centrifuge retention capacity (Office Action, page 3, ¶ 2; page 4, ¶ 2; page 6, ¶ 1). Citing *In re Best*, 195 USPQ 430, 433 (CCPA 1977), the Examiner has argued that the “mere recitation of a newly discovered function, considered as inherently possessed by the prior art process, does not cause claims drawn thereto to distinguish over the prior art” (Office Action, page 3, ¶ 2; page 4, ¶ 2).

Applicants submit that the Examiner’s allegation of inherency is factually deficient. To adequately support an inherency argument, the disclosures relied upon must be sufficient to show that the natural result flowing from the operation as taught by the prior art would result in the claimed subject matter. *Bamberger v. Cheruvu*, 55 USPQ2d 1523, 1534 (BPAI 2000). However, as applicants have previously argued, centrifuge retention capacity depends upon a number of variables beyond simply the type of fiber and crosslinking agent (Request for Reconsideration, page 5, ¶ 2 - page 7, ¶ 1). These variables must be properly adjusted in order to obtain the centrifuge retention capacity recited in claim 37. The recited centrifuge retention capacity therefore does not naturally flow from crosslinking a cellulosic fiber with glyoxylic acid. This fact is clearly demonstrated in the examples on pages 34-46 and Tables 1-5 of the present application. The Panel especially is referred to Example 4 and Table 4 on pages 37-38 of the present application, where it can be seen that Porosanier-J fibers crosslinked with glyoxylic acid at temperatures of 300 °F, 320 °F , and 340 °F resulted in centrifuge retention capacities greater than 0.48 grams.

Furthermore, the mere reliance on the prior art in making out an inherency argument, without more, is insufficient. As stated in *Ex parte Schriker*, 56 USPQ2d 1723, 1725 (BPAI 2000):

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the “page and line” of the prior art which justifies an inherency theory. The examiner has left applicant and the board to guess as to the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which prior art document supports the rejection. We are not good at guessing; hence, we decline to guess.

The facts presented in this request are closely analogous to the facts before the Board in the *Schriker* decision. The Examiner has merely alleged that the prior art and the invention make the fiber in the same way. The Examiner has not pointed to any line number or page of the prior art

(especially in the Examiner's reliance on ADMITTED PRIOR ART) that allegedly discloses the same cross-linking conditions as those described in the specification that result in the claimed characteristics. Without more, applicants respectfully submit that the Examiner has failed to establish a case of inherent anticipation.

The rejection of claims 37-51 under 35 U.S.C. § 103(a) over Sears, U.S. Pat. No. 6,620,293, has been maintained (Office Action, page 4, ¶ 2; page 5, ¶ 3). Applicants have previously explained that Sears is not available as a § 103 prior art reference (Request for Consideration, page 7, ¶ 3-5). However, the Examiner has stated that "Applicant has not shown that the two Applications were commonly owned at the time of the invention." Therefore, the Applicant submits the following statement, in accordance with MPEP § 706.02(l)(1):

#### **STATEMENT CONCERNING COMMON OWNERSHIP**


Applicants respectfully submit that, on the date the present application was filed, the present invention and Sears were commonly owned by or subject to assignment to Rayonier, and therefore Sears cannot be prior art under 35 U.S.C. § 103(a). The recordation of assignment of application no. 10/166,254, from which the present application is a continuation-in-part, is recorded as reel 012992, frame 0833 of the USPTO patent assignment database.

The Office Action has rejected claim 37 under 35 U.S.C. § 112 as introducing new matter due to the following language added thereto in the most recent amendment "a third insult acquisition rate of less than 10 seconds" (Office Action, page 2, ¶ 1-2). Applicants request that they be allowed to enter an amendment of the claim to recite "acquisition time," if this will negate the Examiner's concern regarding the use of "rate" instead of "time." Furthermore, applicants submit that the recited range ("less than 10 seconds") is supported by the specification. The Examiner's contention that "'less than ten' would include times of 0.1 and 9.9, neither of which is disclosed by Applicant" is legally insufficient to support the rejection. It would be impossible to disclose every possible acquisition time that is less than 10 seconds because the range "less than 10" includes an infinite number of acquisition times (*e.g.*, 0.1, 0.01, 0.001, ...). Applicants disclose a number of inventive examples having 3<sup>rd</sup> insult acquisition times less than 10 seconds (see, Table 10, page 45: acquisition times of 8.6, 6.6, 6.1, and 9.0). Applicants believe these data are sufficient to support the language presently recited, but to the

extent the Panel finds alternative language more appropriate, applicants invite any suggestions the Panel may have in this regard.

In view of the foregoing, applicants respectfully submit that the rejections in the Office Action dated April 29, 2005 are factually and legally in error. Should there be any questions concerning this response, Examiner Alvo and other members of the Panel are invited to contact the undersigned at the telephone number listed below.

7/25/05  
Date

Respectfully submitted,  
  
\_\_\_\_\_  
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